

REMARKS

Applicant has amended the claims to overcome the rejection under 35 USC 112, second paragraph.

PRIOR ART REJECTION

In response to the Examiner's rejection of Claims 1-19, 21-39 and 41 under 35 USC 102(b) as being anticipated by U.S. Patent No. 5,496,991 to Delfer, III et al. ("Delfer"), Applicant traverses the rejection. In particular, the examiner has not shown that each element of each claim is disclosed in Delfer and therefore the anticipation rejection is improper and must be withdrawn.

Claims 1 and 3-19

Delfer does not disclose each element of claim 1 and therefore the anticipatory rejection based on Delfer is improper. In particular, Delfer does not disclose" 1) "communicating the payment instructions directly to the payee to initiate payment of the amount"; nor 2) "wherein the payment remittance information is arranged within a data structure, the data structure comprising one or more data fields to hold data that the payor can enter, and the payment remittance information further comprises a structured remittance data that is kept hidden from the payee" for the reasons set forth below and therefore cannot anticipate claim 1. The detailed arguments made in the prior response are incorporated herein by reference and will not be repeated.

"Communicating the payment instructions directly to the payee..." Element

In the Final office action, the examiner asserts that, "Delfer discloses "communicating the payment instructions directly to the payee to initiate payment of the amount" (The bar coded information containing payment instructions is communicated to the sole vendor who may have funds directed to their depository, which is interpreted by the Examiner as payment instructions being communicated directly to the payee to initiate payment of the amount- col. 6, lines 30-40." *See Final Office Action at pg. 2-3.*

This conclusion is inaccurate because, even in the sole vendor embodiment set forth at Col. 6, lines 30-40, the payment instructions are not communicated directly to the payee as set forth in the claims. Delfer discloses that the instructions may be initiated by the vendor's own depository (*See Delfer at Col. 6, lines 35-38*), but "Prior to the requested transactions, the host depository 12

(preferably a bank) has agreed with the billing service provider to act as the legal agency for conducting the inter-depository funds transfer” (*See Delfer at Col. 6, lines 38-42.*) It is clear that, in every embodiment, the billing service is in the middle of the transaction (see Figure 1 flowchart) as Delfer is a billing remittance system. Thus, even in the sole vendor embodiment, the payment instructions from the consumer goes to the billing service who then send those instructions onto the host depository 12 as shown clearly in the flowchart in Figure 1.

Furthermore, the examiner’s assertion for the structured remittance data element below directly contradicts the above assertion because the examiner specifically notes that “The structured remittance data is kept hidden from the payee in that the payor provides information for funds transfer to someone other than the payee (a billing service provider) which the payor does not have access to – col. 4, lines 1-15 and col. 6, lines 30-50.” This statement in Delfer clearly shows that Delfer does not communicate payment instructions directly with the payee. Thus, the examiner’s assertion in the Final Office action is without merit and the independent claims are allowable over Delfer for at least this reason.

“Structured remittance data that is kept hidden from the payee” Element

In the Final Office action, the examiner that in Delfer “The structured remittance data is kept hidden from the payee in that the payor provides information for funds transfer to someone other than the payee (a billing service provider) which the payor does not have access to – col. 4, lines 1-15 and col. 6, lines 30-50.” *Final Office Action at pg. 3.* While the examiner’s recitation of the disclosure in Delfer that the funds transfer is to the billing service provider is correct, Delfer does not specifically disclose that the “structured remittance data is kept hidden from the payee. The examiner’s assertion is mere conjecture and there is nothing in Delfer that specifically discloses that the remittance data is kept hidden from the payee. Thus, Delfer does not disclose this element of the independent claims and the independent claims are allowable over Delfer for at least this additional reason.

In summary, Delfer does not disclose at least two elements of claim 1 and therefore the anticipatory rejection based on Delfer is improper and should be withdrawn.

Claims 3-19 (that depend directly or indirectly on claim 1) were also improperly rejected based on Delfer and the rejection of those claims must be withdrawn as well.

Claim 2

The anticipation rejection of claim 2 based on Delfer is also improper because claim 2 recites “the payment remittance information comprising a structured remittance data that is kept hidden from a payee” and “associating the payment instructions with the structured remittance data; communicating the payment instructions from the memory directly to the payor to initiate payment of the amount” which are not disclosed by Delfer for at least the same reasons set forth above for claim 1 as well in the prior response which is incorporated herein.

Claims 21, 23-39 and 41

Delfer does not disclose each element of claim 21 and therefore the anticipatory rejection based on Delfer is improper. In particular, Delfer does not disclose: 1) “means for communicating the payment instructions directly to the payor to initiate payment of the amount”; and 2) “wherein the payment remittance information is arranged within a data structure, the data structure comprising one or more open data fields to hold data that the payor can enter, and the payment remittance information further comprises a structured remittance data that is kept hidden from the payee” for the reasons set forth below and therefore cannot anticipate claim 21 for the reasons set forth above as well as the reasons set forth in the prior response which are incorporated herein by reference.

In summary, Delfer does not disclose at least two elements of claim 21 and therefore the anticipatory rejection based on Delfer is improper and should be withdrawn.

Claims 23-39 and 41 (that depend directly or indirectly on claim 21) were also improperly rejected based on Delfer and the rejection of those claims must be withdrawn as well.

Claim 22

The anticipation rejection of claim 22 based on Delfer is also improper because claim 22 recites “means for storing a receipt and a payment remittance information, the payment remittance information comprising a structured remittance data that is kept hidden from a payee” and “means for communicating the payment instructions directly to the payor to initiate payment

Appl. No. 09/721,728
Reply dated August 8, 2007
Response to Final Office Action mailed on July 17, 2007

of the amount” which are not disclosed by Delfer for at least the same reasons set forth above for claim 21.

CONCLUSION

In view of the above, it is respectfully submitted that Claims 1-19 and 21-39 and 41 are allowable over the prior art cited by the Examiner and early allowance of these claims and the application is respectfully requested.

The Examiner is invited to call Applicant’s attorney at the number below in order to speed the prosecution of this application.

The Commissioner is authorized to charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 07-1896.

Respectfully submitted,

DLA PIPER US LLP

Dated: August 8, 2007

By /Timothy W. Lohse/
Timothy W. Lohse
Reg. No. 35,255
Attorney for Applicant

DLA PIPER US LLP
2000 University Avenue
East Palo Alto, CA 94303
Telephone: (650) 833-2055